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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RAYMOND J. KELLEY, JACK OBLEIN,  
MOHSIN S. DAWOODBHAI, DAVID M. ORESHACK,  
CHRISTOPHER N. JAPP, and DOUGLAS E. STERN

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Appeal 2008-5599  
Application 09/747,041  
Technology Center 3600

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Decided:<sup>1</sup> May 20, 2009

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Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU  
R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-3, 5-25, 27-50, 52-54, and 56-58 which are all the pending claims in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF THE DECISION

We AFFIRM.

## THE INVENTION

The Appellants' claimed invention is directed to the financial analysis of a transaction for medical resources. The method allows a client to enter and transmit client data for a medical facility to a financial analysis system for a projected financial analysis. The client receives a customized pro forma financial report for the medical facility to enhance financial planning (Spec. 4:2-9). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method comprising:

providing an electronic form comprising a medical-imaging-device purchase-analysis form having fields configured to enable selection of a prospective medical imaging system from a plurality of medical imaging systems and configured to enable entry of financial data including system operational data of the prospective medical imaging system, the financial data comprising projected changes in at least a portion of the financial data over a future analysis period;

electronically receiving the financial data from the electronic form via a network;

routing the financial data into a financial analysis system;  
generating a pro forma financial report for the future analysis period tailored to the financial data;

electronically transmitting the pro forma financial report to a client via the network; and

analyzing a prospective purchasing option selected from a plurality of different purchasing options to obtain the prospective medical imaging system based on the financial data of the client to provide a client-specific financial analysis of the prospective purchasing option.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Eder	US 6,321,205 B1	Nov. 20, 2001
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The following rejections are before us for review:

1. Claims 1-3, 5-25, 27-50, 52-54, and 56-68 are rejected under 35 U.S.C. § 103(a) as unpatentable over Eder.

### THE ISSUE

The issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1-3, 5-25, 27-50, 52-54, and 56-68 under 35 U.S.C. § 103(a) as unpatentable over Eder.

The Appellants contend that the respective claim language to which they cite in the claims is functional descriptive matter which is not shown by

Eder. In contrast the Examiner contends that the Appellants cited claim limitations are non-functional descriptive matter and that Eder has disclosed the claimed invention. The issue turns on whether the respective cited limitations in the claims made by the Appellants are functional or non-functional descriptive matter.

### FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:<sup>2</sup>

FF1. Eder discloses a financial simulation model for evaluating the impact of user-specified changes of business and value drivers (Abstract).

FF2. Eder discloses using the financial simulation model to analyze the impact of user specified changes of value drivers and to generate a list of recommended changes (Abstract).

FF3. Eder discloses using prompts for user input for the financial reports to be viewed, displayed, and printed (Fig. 13, element 806). The prompts for the user are to enter any input required to define data. The user input is then saved to a data table 149 (Col. 18:13-24).

FF4. Eder discloses that the user input is saved and manipulated by application software (Col. 10:15-23).

FF5. Eder discloses that the system generates forecasting financial statements for income, balance, and cash flow and highlights future financial difficulties for corrective action (Col. 13:54-62).

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<sup>2</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF6. Eder discloses that the user receives the processed information from the system (Col. 8:13-21).

## PRINCIPLES OF LAW

### *Principles of Law Relating to Obviousness*

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16, and discussed circumstances in which a patent might be determined to be obvious.

## ANALYSIS

### *Claims 1-3, 5-18, 52-53, and 56*

The Appellants argue that the rejection of the claims under 35 U.S.C. § 103(a) as unpatentable over Eder is improper because the Examiner

focused on the data rather than its function and interrelationship with the resulting report to a client to evaluate a prospective purchase option (Br. 9). The Appellants argue that the Examiner has improperly determined the recitation for the “operational data of medical imaging systems” to be non-functional descriptive material (Br. 9). The Appellants argue that the claims correlate the data to a specific function which is missing from the Eder reference (Br. 10). The Appellants argue that the Eder reference merely discloses a general business evaluation rather than anything related to a specific business transaction or prospective purchase transaction (Br. 11).

In contrast, the Examiner has determined that Eder discloses the method except for a medical imaging-imaging device/system (Ans. 5). The Examiner has found that the recitation of the “operational data of medical systems” and the “medical-imaging-device purchasing analysis form” neither enhance or diminish the functionality of the system. The Examiner considers this information nothing but a compilation of data, which coincides with the definition of non-functional descriptive material (Ans. 5-6).

We agree with the Examiner. The issue here thus turns on whether the Examiner properly determined that the data being processed in the claimed method is non-functional descriptive material. We agree with the Examiner’s determination.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Exemplary “functional descriptive material” consists of data structures and computer programs, which impart functionality when employed as a computer component. “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. *Compare In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) with *In re Warmerdam*, 33 F.3d 1354, 1361-62 (Fed. Cir. 1994) (claim to computer having a specific data structure stored in memory held statutory product-by-process claim but claim to a data structure that referred to ideas reflected in nonstatutory process rather than referring to a physical arrangement of the contents of a memory held nonstatutory).

When presented with a claim including nonfunctional descriptive material, an Examiner must determine whether such material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384; *see also Diamond v. Diehr*, 450 U.S. 175, 191 (1981).

However, the PTO need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See Gulack*, 703 F.2d at 1386. *See also In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004); *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994). The burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO. *In re Lowry*, 32 F.3d at 1584. We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material



and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability. That is, we conclude that such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

Here with regards to claim 1 the Appellants argue that the Eder reference fails to teach or suggest an “electronic form comprising a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system” (Br. 13). The Appellants also argue that Eder fails to disclose “*analyzing a prospective purchasing option... to obtain the prospective medical imaging system*” based on the financial data of the client “*to provide a client-specific financial analysis of the prospective purchasing option*” (Br. 13-14). The Appellants argue that Eder does not teach system operational data for the medical imaging system and instead discloses only “*general non-medical* user inputs which define data fields used by software” (Br. 13).

We find in claim 1 there is not a functional relationship between the operation of the method steps and the medical imaging device data structures recited in the claim. Claim 1 requires providing an electronic form for the input of financial data, receiving the data, routing the data, generating a financial report tailored to the data, transmitting the report to the client, and analyzing the financial report. The recitations in claim 1 for “a *medical-imaging-device purchase-analysis* form having fields configured to enable selection of fields for selecting a *prospective* medical imaging system” (emphasis added) is merely provided data and provides no functional relationship to the method step of providing a form. Likewise, the recitation

in claim 1 for “*analyzing a prospective purchasing option... to obtain the prospective medical imaging system*” (emphasis added) imparts no functional relationship to the operation of the method step of analyzing the prospective purchasing option since the “prospective medical imaging system” is based only on the data. Thus, the two claim limitations cited by the Appellants are non-functional descriptive matter. Here, Eder has disclosed a method of financial modeling to analyze the impact of changes and then listing recommendations (FF1, FF2). Eder discloses the cited claimed limitations of providing an electronic form by using prompts for user inputs of the data and then analyzing the financial options (FF2, FF5). We do not find the subject matter of the operational data for the medical imaging system to be a patentable distinction since Eder discloses the method steps and the medical data elements used in the claimed method do not functionally change the implemented method in that they do not alter how the process steps are to be performed to achieve the utility of the invention. Rather, these data elements are analogous to printed matter in that they represent merely underlying data in a database. *See In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994). As such, the Appellants have failed to demonstrate error in the Examiner’s determination of obviousness of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Eder. The Appellants have not argued the rejections of dependent claims 2-3, 5-18, 52, and 56 separately and the rejection of these claims is sustained for the same reasons as claim 1. With regards to claim 53, the recitation that the medical imaging system is selected from an MRI system, CT system, or ultrasound system also fails to establish a functional relationship between the step of providing a form and the recited medical imaging device data structures.

This case is distinguished from *Lowry*, because in *Lowry* the claims

were directed to data structures stored in memory that contained both information used by application programs and information regarding their physical interrelationships within a memory. *Id.* As such, the court found that the claimed data structures of Lowry's invention were not analogous to printed matter because they managed information by imposing a physical organization on the data and provided increased computing efficiency. *Id.* By contrast, the present invention is directed to a method where the only distinction to the prior art is the content of the data elements. Unlike in *Lowry*, the data in the present case does not impose any functional requirements on the claimed method or otherwise depend functionally on the information content of the data elements which relate to a medical imaging system. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). *See also Ex parte Mathias*, No. 2005-1851 (BPAI Aug. 19, 2005), *aff'd*. *In re Mathias*, No. 2006-1103, 2006 WL 2433879 (Fed. Cir. Aug. 17, 2006) (Rule 36, unpublished) and *Ex parte Curry*, No. 2005-0509 (BPAI Jun. 30, 2005), *aff'd*. *In re Curry*, No. 2006-1003 (Fed. Cir. Jun. 12, 2006) (Rule 36, unpublished) (both cases treating data as nonfunctional descriptive material).

*Claims 19-25, 27-33, and 57*

The Appellants similarly argue that the rejection of claim 19 is improper because it includes a limitation for an interface “wherein the interface includes a medical diagnostic-device purchase-analysis-form

having fields configured to enable selection of a prospective medical imaging system” which is not shown by Eder (Br. 14). The Appellants also argue that claim 19 includes a limitation for a system configured to generate a projected financial report tailored to client data “wherein the projected financial report enables a client to evaluate feasibility of purchasing the prospective medical imaging systems” which is not shown by Eder (Br. 14).

Similar to our analysis for claim 1, we determine that the recitations here for the interface to include “a *medical diagnostic-device purchase-analysis-form* having fields *configured to enable selection of a prospective medical imaging system*” (emphasis added) and that the “projected financial report enables a client to evaluate *feasibility of purchasing the prospective medical imaging system*” (emphasis added) is non-functional descriptive matter which fails to establish a functional relationship between the system interface and the medical imaging device data structures. These cited recitations in claim 19 are merely provided data and provide no functional relationship to the system interface or financial reports. Eder discloses the claimed limitations of providing a system interface and form by disclosing using prompts for user inputs of the data (FF3). Eder also discloses generating forecasting financial statements (FF5) and recommending changes (FF2) meeting the claimed limitations. For these reasons the Appellants have failed to demonstrate error in the Examiner’s determination of obviousness of claim 19 under 35 U.S.C. § 103(a) as unpatentable over Eder. The Appellants have not separately argued the rejections of dependent claims 20-25, 27-33, and 57 and the rejection of these claims is sustained for the same reasons as claim 19.

*Claims 34-42, 54, and 58*

The Appellants similarly argue that the rejection of claim 34 is improper because it includes a limitation for “providing an interface having a form comprising a medical-imaging-device purchase-analysis form configured to enable selection of prospective medical imaging system” and a form for “entering *client data* relating to the healthcare facility including system operational data of the prospective medical imaging system” (Br. 15). The Appellants also argue that claim 34 also recites “returning a pro forma financial report to a client via the network to enable the client to evaluate feasibility of a possible transaction to obtain the prospective medical imaging system” (Br. 16) which is not shown Eder.

Similar to our analysis for claim 1, we find that the recitations in claim 34 for the interface form “comprising a medical-imaging-device purchase-analysis form configured to enable selection of prospective medical imaging system” and for “entering client data relating to the healthcare facility including system operational data of the prospective medical imaging system” is non-functional descriptive matter which fails to establish a functional relationship between the system interface form and the medical imaging device data structures. Eder discloses the claimed limitations of providing an interface and form by disclosing using prompts for user inputs of the data (FF3). Further, the recitation for the financial report to enable a client to “evaluate feasibility of a possible transaction to obtain the prospective medical imaging system” is also non-functional descriptive matter which does not establish a functional relationship between the financial reports and the medical imaging device data structures. These cited recitations in claim 34 are merely provided data and provide no functional relationship to the system interface or financial reports. Eder has

disclosed generating financial reports by creating forecasting financial statements (FF5) and recommending changes (FF2). For these reasons the Appellants have failed to demonstrate error in the Examiner's determination of obviousness of claim 34 under 35 U.S.C. § 103(a) as unpatentable over Eder. The Appellants have not separately argued the rejections of dependent claims 35-42, 54, 58 and the rejection of these claims is sustained for the same reasons as claim 34.

#### *Claims 43-50*

The Appellants similarly argue that the rejection of claim 43 is improper because it includes limitations for “an Internet query form having a medical-diagnostic-device purchase-analysis-form having a plurality of data entry fields configured for accepting financial data of a prospective medical diagnostic system” wherein the entry fields include “a medical *operational time field associated with efficiency of the prospective medical diagnostic system for a potential purchase transaction*” and “a revenue field associated with the *medical diagnostic system*” (Br. 16).

Similar to our analysis for claim 1, we find that the recitations here for the query form to have “a medical-diagnostic-device purchase-analysis-form having a plurality of data entry fields configured for accepting financial data of a prospective medical diagnostic system” with fields for “a medical operational time field associated with efficiency of the prospective medical diagnostic system for a potential purchase transaction” and a “revenue field associated with the prospective medical diagnostic system” to be non-functional descriptive matter which fails to establish a functional relationship between the system form and the medical imaging device data structures. The cited recitations in claim 43 are merely provided data and

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provide no functional relationship to the system interface or financial reports. Eder discloses the claimed limitations of providing an interface and form by disclosing using prompts for user inputs of the data (FF3). For these reasons the Appellants have failed to demonstrate error in the Examiner's determination of obviousness of claim 43 under 35 U.S.C. § 103(a) as unpatentable over Eder. The Appellants have not separately argued the rejections of dependent claims 44-50 and the rejection of these claims is sustained for the same reasons as claim 43.

#### CONCLUSIONS OF LAW

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 1-3, 5-25, 27-50, 52-54, and 56-68 under 35 U.S.C. § 103(a) as unpatentable over Eder.

#### DECISION

The Examiner's rejection of claims 1-3, 5-25, 27-50, 52-54, and 56-68 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

#### AFFIRMED

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